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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/026,156	12/18/2001	Steven O. Markel	Inte.24USU1	9484

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EXAMINER	
QUELER, ADAM M	

ART UNIT	PAPER NUMBER
2178	

DATE MAILED: 05/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/026,156	MARKEL, STEVEN O.	
	Examiner	Art Unit	
	Adam M. Queler	2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 March 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-3,6-8 and 17-23* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-3,6-8 and 17-23* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This action is responsive to communications: RCE filed 04/27/2006, and Amendment filed 03/27/2006.

2. Claims 1-3, 6-8, and 17-23 are pending in the case. Claims 1, 17, and 19 are independent claims.

3. The rejections of claims 6-8 under § 112 have been withdrawn.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1-3, 6-8, 20, 21, and 23 remain rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The claims are drawn to functional descriptive material NOT claimed as residing on a computer readable medium. MPEP 2106.IV.B.1(a) (Functional Descriptive Material) states:

> "Data structures not claimed as embodied in a computer-readable medium are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer."
>
> "Such claimed data structures do not define any structural or functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure's functionality to be realized."

The claims, while defining a system, do not define a "computer-readable medium" and is thus non-statutory for that reasons. A system can range from paper on which the program is written, to a program simply contemplated and memorized by a person. The Office suggests amending the claim to embody the program on "computer-readable medium" in order to make the claim statutory.

> "In contrast, a claimed computer-readable medium encoded with the data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory." - MPEP 2106.IV.B.1(a)

Claims 1-3, 6-8, and 17-23 are rejected as being directed to an abstract idea with no practical application. In order to be considered a practical application of an abstract idea, the claims must provide a practical application that produces a useful, tangible and concrete result. See "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility" § IV.C.2.b. In this case, no tangible result is apparent in any of the claims. The integrated signal does not appear to be a tangible result.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1 and 22 remain rejected under 35 U.S.C. 102(e) as being anticipated by Gupta et al (US 20030196164A1, filed 9/15/1999).

Regarding independent claim(s) 1 and 22, Gupta discloses a user interface and input box for identifying content (Fig. 8, 262). Gupta discloses a prompt and input box for entering a start time that content will be displayed (Fig. 8, 268). Gupta discloses a monitor that displays a data signal and a video signal (Fig. 3), which inherently must be integrated. A monitor does not understand any of the content that it displays. All the monitor is told is what pixels to make what

color and where. As such the signal that is sent to a monitor is a signal with all the various logical content (such as data and video) to be displayed integrated into the display signal.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. Claims 2-3, and 6-8 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Gupta, and further in view of Bayeh et al (US006012098A, filed 2/23/1998).

Regarding dependent claim(s) 2, Gupta teaches that the content is stored in a database (para. 47). Gupta does not disclose storing the content as XML. Bayeh teaches translating stored content into XML (col. 8, ll. 3-18). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Bayeh and Gupta, therefore translating the content, in order to provide a standardized output (Bayeh, col. 8, ll. 19-22).

Regarding dependent claim(s) 3, Gupta does not teach generating an HTML file. Bayeh teaches an XSL parser to generate an HTML file (col. 9, ll. 5-8). It would have been obvious to one of ordinary skill in the art at the time of the invention to format the information as HTML because browsers expected to receive HTML (col. 2, ll. 52-53).

Regarding dependent claim(s) 6-8, Gupta does not expressly show the specific data claimed. However, these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The processing step would be performed the same regardless of the data. Thus, this descriptive material will not distinguish the claimed

invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to process any type of data because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

10. Claims 17-19 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Gupta, and further in view of Bayeh, and further in view of Logan (US 20030093790A1, priority date 3/28/2000).

Regarding independent claim(s) 17, Gupta discloses a user interface (Fig. 8, 262). Gupta discloses a prompt and input box for entering a start time and end time capable of selecting a particular frame (Gupta, para. 61). Gupta teaches that the content is stored in a database (para. 47). Gupta discloses a monitor that displays a data signal and a video signal (Fig. 3), which inherently must be integrated. A monitor does not understand any of the content that it displays. All the monitor is told is what pixels to make what color and where. As such the signal that is sent to a monitor is a signal with all the various logical content (such as data and video) to be displayed integrated into the display signal. Gupta does not disclose storing the content as XML. Bayeh teaches translating stored content into XML (col. 8, ll. 3-18). Bayeh teaches a first XSL parser to generate a first HTML file (col. 9, ll. 5-8). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Bayeh and Gupta, therefore translating the content, in order to provide a standardized output (Bayeh, col. 8, ll. 19-22). Gupta and Bayeh do not explicitly disclose a television program, but a general multimedia presentation

(Gupta, para. 4). Logan discloses integrating the content into the television program (para. 80). It would have been obvious to one of ordinary skill in the art at the time of the invention to extend the general multimedia presentations of Gupta and Bayeh into the television program of Logan, thereby integrating the HTML code into the television program, in order to display more information about television program (Logan, para. 6).

Regarding dependent claim(s) 18, Gupta does not teach generating an HTML file. Bayeh teaches a second XSL processor for different presentation requirements, (col. 8, ll. 55-57), which would encompass a different device. It would have been obvious to one of ordinary skill in the art at the time of the invention to format the information as HTML because browsers expected to receive HTML (Bayeh, col. 2, ll. 52-53).

Regarding independent claim(s) 19, Gupta entering content information (Fig. 8, 262). Gupta teaches that the content is stored in a database (para. 47). Gupta discloses a monitor that displays a data signal and a video signal (Fig. 3), which inherently must be integrated. A monitor does not understand any of the content that it displays. All the monitor is told is what pixels to make what color and where. As such the signal that is sent to a monitor is a signal with all the various logical content (such as data and video) to be displayed integrated into the display signal. Gupta does not disclose storing the content as XML. Bayeh teaches translating stored content into XML (col. 8, ll. 3-18). Bayeh teaches a first XSL parser to generate a first HTML file (col. 9, ll. 5-8). Bayeh teaches a second XSL processor for different presentation requirements, (col. 8, ll. 55-57), which would encompass a different device. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Bayeh and Gupta, therefore translating the content, in order to provide a standardized output (Bayeh, col. 8, ll. 19-22). Gupta

and Bayeh do not explicitly disclose a television program, but a general multimedia presentation (Gupta, para. 4). Logan discloses integrating the content into the television program (para. 80). It would have been obvious to one of ordinary skill in the art at the time of the invention to extend the general multimedia presentations of Gupta and Bayeh into the television program of Logan, thereby integrating the HTML code into the television program, in order to display more information about television program (Logan, para. 6).

11. Claims 20, 21, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gupta as applied to claim 1 above, and further in view of Applicant's Admitted Prior Art.

Regarding dependent claim(s) 20, Gupta does not explicitly disclose the webTV format. Applicant admits that the WebTV format was one that must be considered, and was therefore was a desired format at the time of the invention (p. 1). It would have been obvious to one of ordinary skill in the art at the time of the invention to use the WebTV format for that desired reason.

Regarding dependent claim(s) 20, Gupta does not explicitly disclose the AOLTV format. Applicant admits that the AOLTV format was one that must be considered, and was therefore was a desired format at the time of the invention (p. 1). It would have been obvious to one of ordinary skill in the art at the time of the invention to use the AOLTV format for that desired reason.

Regarding dependent claim(s) 23, Gupta does not explicitly disclose displaying a signal on two monitors. Official Notice is taken that it was well-known and common at the time of the invention to display a signal on two monitors. Therefore it would have been obvious to one of

ordinary skill in the art at the time of the invention to display the signal on a plurality of monitors to display the signal to two different people.

Response to Arguments

12. Applicant's arguments filed 03/27/2006 have been fully considered but they are not persuasive.

Regarding Applicant's remarks on §101 rejections of claim 1:

Applicant alleges the amendments moot the rejections. The Office does not see how, and the rejection has been maintained and further expanded.

Regarding Applicant's remarks on Claim 1:

Applicant alleges that Gupta does not teach an integrated signal. However, Gupta discloses a monitor that displays a data signal and a video signal (Fig. 3), which inherently must be integrated. A monitor does not understand any of the content that it displays. All the monitor is told is what pixels to make what color and where. As such the signal that is sent to a monitor is a signal with all the various logical content (such as data and video) to be displayed integrated into the display signal.

The rest of the Applicant's remarks are analogous to the ones above and have been answered above.

Conclusion

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adam M. Queler whose telephone number is (571) 272-4140. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AQ

STEPHEN HONG
SUPERVISORY PATENT EXAMINER